

### REMARKS

This communication responds to the Office Action (*Office Action*) having an electronic notification date of March 10, 2010. Claims 1 and 3-8 are amended, claim 2 was previously canceled, claims 9-12 are presently canceled, and claims 22-25 are added. As a result, claims 1, 3-8 and 22-25 are now pending in this application.

#### Claim Objections

On page 2 of the *Office Action* the Examiner objected to claims 9-12 as being of improper dependent form for failing to further limit the subject matter of a previous claim. In answering the Examiner's objection, the Applicants have canceled claims 9-12 and added a new set of claims commencing with independent claim 22.

#### Rejection of the Claims under 35 U.S.C. § 103(a)

On page 3 of the *Office Action*, the Examiner rejected claims 1 and 3 under U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,236,980 to Reese in view of U.S. Patent No. 6,408,309 to Agarwal and further in view of U.S. Patent No. 6,996,539 to Wallman (*Wallman I*). Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provided a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known in the prior art*** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and ***the combination would have yielded nothing more than predictable results*** to one of ordinary skill in the art.<sup>1</sup>

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all the limitations of Applicants' claimed elements, nor is there any substantiating evidence that any combination of the references would have yielded predictable results. "If any

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<sup>1</sup> See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

of these [three] findings cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."<sup>2</sup>

Although other rationales for rejection under 35 U.S.C. § 103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. "***All words in a claim must be considered*** in judging the patentability of that claim against the prior art."<sup>3</sup> Additionally, to render the claimed subject matter obvious, the prior art references ***must*** teach or suggest every feature of the claims.<sup>4</sup> ***Emphasis Added.***

In particular, Applicants' amended independent claim 1 recites, in part, that

[S]electing, according to a first user, a preference of an investment or a weighted apportionment of assets for a set of investments, the first user being a submitting user associated with the preference and ***a member of a first population of users***, the first population of users ***being members of a virtual community*** and identified as investment analysts; [and]

deriving, in response to the updated set of preferences, ***a position of a financial product for a second user, the second user being a member of a second population*** of users, the second population of users ***being members of the virtual community*** and identified as investors, and the financial product is a mutual fund. ***Emphasis Added.***

On page 5 of the *Office Action* the Examiner cited to *Wallman I* in regard to Applicants' claim 1. In contrast to Applicants' amended independent claim, *Wallman I* merely discusses that,

There are, and have been a ***variety of systems*** (for example, ***Schwab One Source***, ***Financial Engines*** and a ***new Microsoft site***) that provide advice to investors as to the creation of a portfolio of

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<sup>2</sup> MPEP § 2143.

<sup>3</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); emphasis added. See also MPEP § 2143.03, emphasis added.

<sup>4</sup> See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaack*, 947 F.2d, 488 (Fed. Cir. 1991)). Cited approvingly in *Ex parte WEN WEN* and PATRICIA NG at 7; Appeal No. 2009-000776; decided September 25, 2009.

mutual funds based on . . . risk, style, performance, and ratings.<sup>5</sup>  
***Emphasis Added.***

The advice to investors in *Wallman1* comes from financial engines, websites, and systems that are intended for providing advice to investors in creating a portfolio of certain mutual funds. *Wallman1* discusses systems that are generally available to anyone having access to the Internet. *Wallman1* is silent as to any requirement for a particular association or membership for those investors desiring access. In contrast to the systems disclosed in *Wallman1*, Applicants' amended independent claim 1 recites that "the first user being a . . . member[]" of a virtual community and identified as [an] investment analyst[]" and "a financial product for a second user . . . being [a] member[] of the virtual community and identified as [an] investor[]." The investment analysts and investors recited in Applicants' claim elements clearly have a relationship to one another based on their membership in a virtual community.

The situation recited in Applicants' independent claim 1, with a virtual community having a membership-based relationship between investment analysts and investors, is not equivalent to the variety of systems that provide advice to investors in *Wallman1*. Therefore, at least this claim element is not known in the prior art, as required by the KSR court, and a conclusion that Applicants' independent claim 1 would have been obvious is not supported by the rationale put forth by the Examiner.

Applicants' amended independent claim 1 also recites, in part, that

[R]eceiving over a wide-area network an indication of the preference; [and]  
aggregating the preference into a database of previously ***received preferences from the first population***, the aggregation being an updated set of preferences. ***Emphasis Added.***

On page 3 of the *Office Action* the Examiner cited to *Reese* in regard to Applicants' claim 1. In contrast to amended independent claim, *Reese* merely discusses that,

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<sup>5</sup> *Wallman1*, at column 6, lines 9-14, emphasis added.

[A] security recommendation reporting system that is ***based on recommendations*** of securities ***in various published magazines, online sources, or broadcast programs.***<sup>6</sup> ***Emphasis Added.***

The user saves time by getting, in one place, the summary of articles, from ***a large variety of sources***, that are recommendations about the single element he or she is interested in.<sup>7</sup> ***Emphasis Added.***

[T]he invention could be utilized to display the recommendations of elements other than securities . . . the system could ***display the recommendations*** for computer parts from well-respected computer analysts across ***a multitude of magazines, online sources, and broadcast media.***<sup>8</sup> ***Emphasis Added.***

Here, *Reese* discusses how a security recommendation reporting system produces various reports based on a large variety of published magazines, online sources, and broadcast programs. The discussions in *Reese* expound upon a large variety of sources for even a single element of interest by a user. In contrast, Applicants' amended independent claim 1 recites aggregating a preference into a database of previously ***received preferences from the first population.*** ***Emphasis Added.*** A single source of preferences, *i.e.*; the first population, is cited in Applicants' claim elements. The large variety of sources, as disclosed by *Reese*, is not only contrary to Applicants' claim 1 but also teaches away from the recited preferences received from the first population. At least the claimed element of receiving preferences from a first population is not known in the cited prior art, as required by the KSR court. Therefore, the cited prior art cannot support a conclusion that Applicants' amended independent claim 1 would have been obvious.

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Reese* singly or in any combination with *Agarwal* or *Wallman I*, Applicants respectfully requests the Examiner withdraw the rejection under 35 U.S.C. §103(a) with regard to independent claim 1 that Applicants assert is patentable. Further, claims 3-8 depend from claim 1. Thus, these dependent claims are allowable for at least the same reasons as claim 1 from which they depend. Additionally, each of these dependent claims may contain additional patentable subject matter.

<sup>6</sup> *Reese*, at column 2, lines 33-36, emphasis added.

<sup>7</sup> *Id.*, at column 2, lines 51-54, emphasis added.

<sup>8</sup> *Id.*, at column 3, lines 34-37, emphasis added.

Rejection of Additional Dependent Claims under 35 U.S.C. § 103(a)

On page 6 of the *Office Action*, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as allegedly being obvious over *Reese* in view of *Agarwal* in view of *Wallman1* and further in view of U.S. Patent No. 6,049,783 to Segal et al (*Segal*). On page 7 of the *Office Action*, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as allegedly being obvious over *Reese* in view of *Agarwal* in view of *Wallman1* and further in view of U.S. Patent No. 6,473,084 to Phillips et al (*Phillips*). On page 7 of the *Office Action*, the Examiner rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being obvious over *Reese* in view of *Agarwal* in view of *Wallman1* and further in view of U.S. Patent No. 6,338,047 to Wallman (*Wallman2*).

However, each of these claims depends, directly or indirectly; from claim 1 that Applicants assert is patentable. The cited references from each of: *Segal*, *Phillips*, or *Wallman2* singly fails to supply the elements of the independent claims that were shown above to be missing from *Reese*, *Agarwal*, or *Wallman1*. Therefore, a person having ordinary skill in the art, having carefully considered *Reese*, *Agarwal*, *Wallman1*, *Segal*, *Phillips*, or *Wallman2*, whether alone or in any combination, would not conclude that the limitations of the independent claims are obvious as is required to support a *prime facie* case of obviousness in rejecting these claims of the present application under 35 U.S.C. § 103(a). Consequently, Applicants respectfully request that the rejection made under 35 U.S.C. § 103(a) with respect to these dependent claims be reconsidered and withdrawn. Moreover, each of these dependent claims may be patentable for its own limitations presented therein.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(513) 942-0224

Date 10 June 2010

By



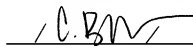
Joseph P. Mehrle

Reg. No. 45,535

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of June, 2010.

Chris Bartl

Name



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